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materials together, wherein said materials are selected from the group consisting of metal and wood.

64. A method of using the inorganic resin composition according to claim 47 comprising applying said said cured, prepreg shape to a damaged concrete surface in order to repair or restore said surface.

65. A method of using the inorganic resin composition according to claim 47 comprising incorporating said cured, prepreg shape into concrete.

REMARKS

The claims presented for reconsideration are claims 29-65.

Claims 31, 32, 35, 36, 43, 46-48, 51, 52, 54, 55, 57, and 58 are rewritten, hereby, in order to address issues raised in the outstanding Office action, as further explained, below. New claims 60-65 represent subject matter that was deleted from the aforesaid rewritten claims by the instant amendment.

Applicants wish to thank Examiner Green for the reconsideration given the instant application, following their amendment filed May 21, 1999. Accordingly, the prior art rejections were withdrawn, as indicated in the outstanding Office action.

Claims stand rejected under 35 U.S.C. 112, second paragraph, for allegedly containing indefinite claim language. Reconsideration is respectfully requested in view

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of the changes to the claims effected by the instant amendment, taken in conjunction with the following remarks.

According to the statement of rejection, claim 29 is rejected for allegedly being "unclear as to the amount of each component present in the composition" (Office action, page 2). Applicants respectfully submit that claim 29 is incorrectly rejected.

The test for indefinite claim language is whether one of ordinary skill in the art would be confused as to the subject matter circumscribed by the language at issue. *In re Kroekel*, 183 USPQ 610 (CCPA 1974). When the PTO applies this test to a claim, "a rejection based on indefiniteness cannot stand simply because the proportions actually recited in the claims may be read in theory to include compositions that are impossible in fact to formulate." 183 USPQ at 612.

The purpose of the claims is to define the legal limits of the invention; the purpose of the specification is to detail how the invention is to be practiced. *In re Roberts*, 176 USPQ 313, 315 (CCPA 1973). In the instant situation, the amounts of components necessary relate to *how* the invention is to be practiced and, therefore, are properly found in the specification, not the claims.

Moreover, the issued raised with respect to claim 29 concerns the scope of the claim; that is, incorporating amount limitations into the claim would, literally, narrow the breadth of the claim. However, it is well established that claim "breadth is not to

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be equated with indefiniteness" under §112, second paragraph. *In re Miller*, 169 USPQ 597, 600 (CCPA 1970). This only stands to reason as, under U.S. patent law, a patent applicant is entitled to claim his invention *generically*. While a patent applicant may so choose to limit his invention to a specific embodiment described in the specification, "it is not necessary to embrace in the claims . . . also possible forms in which the claimed principle may be reduced to practice." *Smith v. Snow*, 294 U.S. 1, 11 (1935). (Furthermore, a patent applicant is not required to describe in his specification every embodiment possible in which the claimed principle is reduced to practice.)

Whether the claims are broader than the embodiments described in the specification (with respect to amounts of components) is insufficient to sustain a rejection under 35 U.S.C. 112, second paragraph. Moreover, to the extent that the instant claims might, theoretically, read on amounts of components that might not be sufficient, when evaluating a claim under §112, the PTO does not read the claim to include inoperative embodiments. *Tsuchiya v. Woods*, 220 USPQ 984 (BPA & I 1983). The "use of materials which might prevent achievement of the objective . . . can hardly be said to be within the scope of the claims." *In re Geerdes*, 180 USPQ 789, 793 (CCPA 1974). Accordingly, withdrawal of the rejection under 35 U.S.C. 112, second paragraph, against claim 29 is respectfully requested.

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Claim 31 was considered indefinite, according to the statement of rejection, with respect to the term "hydrates." In accordance with the instant amendment, claim 31 is rewritten in a manner that resolves any potential for confusion with respect to the use of "hydrates" in the claim. Present claim 32, while not rejected, is amended, hereby, with respect to "hydrates" in a manner similar to claim 31, for consistency.

Claim 35 was rejected because, according to the statement of rejection the term "the equivalent of" rendered the claim indefinite. In accordance with the instant amendment, the term "the equivalent of" is deleted from the claim, rendering the rejection moot. Claim 36 is, similarly, amended, by deleting the term "the equivalent of," although claim 36 was not rejected.

Claim 46 was rejected because, according to the statement of rejection, it contained an allegedly improper Markush grouping; specifically, it being alleged that the Markush grouping was improper for including a "metal fiber" and an "inorganic fiber" in the same Markush group. Applicant respectfully submits that it is not improper to include in the same Markush grouping a generic term and a species of the generic term. In order to move prosecution forward, the Markush grouping in claim 46 is amended, hereby, to read "selected from the group consisting of metal fiber, organic fiber, and non-metal inorganic fiber." Applicants respectfully submit that

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rewriting claim 46 in this manner overcomes the rejection by rendering the claim terms at issue mutually exclusive.

Claim 47 was rejected as being indefinite for containing the terminology "in a cured, shaped form." According to the statement of rejection, the term was confusing as, allegedly, meaning either "physically placed into a cured shaped form" or "in the form of a cured shape." Since the Examiner considers that the terminology "in the form of a cured shape" to be sufficiently self-defining, applicants have revised claim 47 to read in the same manner; that is, claim 47 now reads that the composition is "in the form of a cured shape."

Claim 48 was rejected as being indefinite for using the terminology "in a cured, shaped prepreg form." As in the statement of rejection against claim 47, in the statement of rejection against claim 48 the Examiner set forth language he considered to be self-definitive, that is, "in the form of a cured prepreg shape." Accordingly, claim 48 is amended, hereby, to contain the language considered by the Examiner to be sufficiently self-definitive; that is, claim 48 now reads the composition "in the form of a cured, prepreg shape."

Although claim 51 was not rejected for the same reasons as claim 47, applicants have amended claim 51 in the same fashion as claim 47 is amended,

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hereby. Since claim 51 is dependent on claim 47, amending claim 51 in this fashion maintains clearer antecedent basis from parent claim 47.

Claims 51 and 52 were rejected as being indefinite for, essentially, defining a different statutory class of invention; that is, claims 47 and 48 define a composition of matter, and claims 51 and 52 dependent, respectively, thereon, define a process. With all due respect, applicants submit that claims 51 and 52 are not indefinite, and cannot be rejected under §112, second paragraph, for this reason.

Each of claims 51 and 52 define a process for making the composition defined, respectively, in each of claims 47 and 48. In fact, the dependency relationship between claims 47 and 51, and claims 48 and 52, is expressly indicated as being proper in the manual of patent examining procedure, specifically, MPEP 608.01(n)(3), which reads:

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1.

Withdrawal, therefore, of improper claimed dependency as a reason for rejecting claims 51 and 52 is indicated.

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Claims 51 and 52 were also rejected as being indefinite for including the terminology "bringing said slurry on a surface that at least partially supports said slurry" (claim 51) and "bringing said prepreg on a surface that supports said prepreg" (claim 52). In accordance with the instant amendment, claim 51 is rewritten with respect to the terminology at issue so as to read

Applying said slurry on a surface, wherein said slurry sets to the form of the cured shape of the inorganic resin composition.

Claim 52 is, similarly, amended. Applicants respectfully submit that, in view of the changes effected to claims 51 and 52, the operational language of these claims, as amended, overcomes any potential for confusion and satisfies the requirements of §112, second paragraph, of the statute.

Claim 54 was rejected for allegedly containing improper Markush terminology. Applicants respectfully submit that claim 54 as presently amended, which recites "wherein said surface comprises a fiber mat made of fibres," overcomes the rejection.

Claim 55 was rejected for allegedly being indefinite as being "confusing as written." With all due respect, applicants consider that claim 55, as originally submitted, satisfies the requirements of §112, second paragraph (had they not, they would not have submitted the claim in that form). Moreover, little explanation is provided in the rejection as to how claim 55 is considered indefinite. In any event,

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applicants have revised claim 55 in accordance with the instant amendment in order to more clearly define the invention. It is respectfully requested that, should the Examiner consider claim 55, as amended, still indefinite, more detail be provided as to the reasons the rejection is maintained.

Claims 57 and 58 were rejected for reasons similar to those set forth in the statements of rejection of claims 51 and 52; that is, claim 57 defines a "method" and claim 29, on which claim 57 depends, defines a composition. Claims 58 and 47 are in the same claim dependency relationship as claims 57 and 29.

Applicants respectfully submit that, as indicated above with respect to claims 51 and 52, claims are not improperly dependent merely because they define a different statutory class of subject matter. MPEP 608.01(n)(3). Accordingly, withdrawal of the rejections of claims 57 and 58 for being allegedly improper dependent claims is indicated.

Claims 57 and 58 were, further, rejected for being allegedly indefinite for allegedly not reciting "any active, positive steps delimiting [sic] how this use is actually practiced." Applicants respectfully submit that, as an initial matter, "how" the invention "is actually practiced" is the function of the specification, not the claims, as explained above. *Roberts, supra*. In any event, applicants have amended claims 57

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and 58 in order to more clearly define the instant invention, such that claim 57 (amended) reads:

A method of using the inorganic resin composition according to claim 29 comprising incorporating said composition as a binder into a coating or surfacing agent.

Claim 58 is, similarly, amended, in that the claim recites the active step of "incorporating." Therefore, applicants respectfully submit that, in view of the amendments to claims 57 and 58, whereby "incorporating" is the active step recited, overcomes any potential confusion and satisfies the requirements of §112, second paragraph, of the statute.

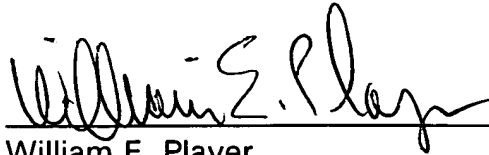
In amending claims 57 and 58, hereby, to more clearly define the invention, subject matter was deleted from each of these claims. Specifically, the presently claimed invention includes using (that is, "incorporating") the "composition" of the invention and the "cured prepreg" of the invention in adhesives and as cementing agents (that is, in concrete). In order to cover this subject matter, new claims 60-65 are added, hereby. Being subject matter taken from the claims of record, and, further, being dependent on claims of record (that is, claims 29, 47, and 48), new claims 60-65 are properly included in the instant application.

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Favorable reconsideration is requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "William E. Player", written over a horizontal line.

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